REMARKS

Claims 1-39 are present in this application and have been subjected to restriction by the Examiner under 35 U.S.C. §§121 and 372 as follows:

Group I. claims 1-24 and 26-39, drawn to full-length DNA.

Group II. claim 25, drawn to an oligonucleotide.

In support of the restriction requirement, the Examiner has alleged that that "the inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features." Specifically, the Examiner has alleged that there is no special technical feature which links the full-length DNA of Group I and the oligonucleotide of Group II under PCT Rule 13.2. The Examiner has required Applicants to elect a single invention.

In order to be fully responsive to the Examiner's requirements for restriction, Applicants provisionally elect, with traverse, to prosecute the subject matter of Group I, claims 1-24 and 26-39. However, pursuant to 37 C.F.R. §§1.111 and 1.143, Applicants hereby traverse the Examiner's requirement for restriction and request reconsideration thereof in view of the following remarks.

A requirement for restriction presupposes an analysis of the subject application in light of the rules governing this practice, i.e., 37 C.F.R. §1.499 and PCT Rules 13.1 and 13.2.

PCT Rule 13.1, first sentence, states: "The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention")." (Emphasis added.)

Applicants submit that Groups I and II are related to each other and represent one single inventive concept warranting examination in a single application. In particular, Group I is directed to isolated nucleic acid molecules, genetic constructs comprising such molecules, transgenic plants or parts thereof comprising such molecules and methods of using such molecules. For example, claims 3-12 of Group I are drawn to isolated nucleic acid molecules comprising a sequence that is complementary to, substantially the same as, having at least about 60% similarity to, or capable of hybridizing to, one of SEQ ID NOS: 1, 3, 5, 7, 9, 14, 16, 16, 18, 20, 22 or 24. Claim 25 of Group II is directed to an oligonucleotide capable of hybridizing to a sequence selected from SEQ ID NOS: 1, 3, 5, 7, 9, 14, 16, 16, 18, 20, 22 and 24. Clearly, the oligonucleotide of Claim 25 of Group II is closely linked to the isolated nucleic acid molecules of Group I. As such, Applicants submit that Group I and Group II are united under a single general inventive concept and should be examined together in the present application.

Furthermore, Applicants respectfully suggest that, in view of the continued increase of official fees and the potential limitation of an applicant's financial resources, a practice

which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional purpose to promote and encourage the progress of science and the useful arts. Moreover, under the regulatory changes as a consequence of the General Agreement on Trade and Tariffs (GATT), Applicants are required to conduct simultaneous prosecution, as here, requiring excessive cost or the loss or compromise of the term of the related patent assets.

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations.

The Court of Appeals for the Federal Circuit has declined to hold that §121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 288 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990) that court held that §121 does not insulate a patentee from an allegation of "obviousness-type" double patenting, and in

fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which an applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee's rights and to serve the public's interest in the legitimacy of issued patents, Applicants respectfully urge the Examiner not to require restriction in cases such as the present application wherein various aspects in a unitary invention are claimed.

In view of the foregoing comments, it is respectfully urged that the Examiner reconsider and withdraw the requirement for restriction and provide an action on the merits with respect to all the claims.

Respectfully submitted,

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